

DOCKET NO: 204395US0X PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

YUKINO OWAKI, ET AL.

SERIAL NO: 09/786,370

FILED: MARCH 15, 2001

FOR: TAPE MATERIAL FOR
TRANSCUTANEOUS ABSORPTION

:

: EXAMINER: GOLLAMUDI, S.

:

: GROUP ART UNIT: 1616

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LETTER TO THE EXAMINER

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants thank Examiner Gollamudi for the helpful and courteous discussion of December 3, 2004. During the discussion, the Examiner indicated that both the Examiner and the Examiner's supervisor were in agreement that the Declaration under 37 C.F.R. §1.132, submitted on August 16, 2004, may be sufficient for demonstrating the patentability of invention compositions which contain 5% by weight of butyl rubber. The Examiner noted that the data of the Declaration may not be commensurate in scope with the claimed subject matter because the non-aqueous tape preparation of present Claim 1 permits the butyl rubber to be present in an amount of 1-30%. The Examiner indicated that she may consider a further Declaration under 37 C.F.R. §1.132 which demonstrates the superiority of the claimed tape preparation over the closest prior art if any further Declaration provided information commensurate in scope with the claimed subject matter (e.g., tape preparations containing 1%, 15%, 20% and 30% of butyl rubber).

Applicants submit herewith a Declaration under 37 C.F.R. §1.132 providing further data demonstrating the superiority of the claimed tape preparation for compositions containing butyl rubber in amounts of 1%, 15%, 20% and 30%. The data of the present Declaration and the Declaration submitted on August 16, 2004 may be considered together because they are undertaken under the same conditions (see for example the conditions described in "Applicability test" in section 2 of each of the Declarations).

As is readily evident by comparing Table 1 of the present Declaration with Table 1 of the Declaration of August 16, 2004, each of the invention preparations containing 1%, 15%, 20% and 30% of butyl rubber provide significantly superior adhesion as measured by "Turn Up" in comparison to the comparative preparation and the D1 preparation shown in the Declaration of August 16, 2004.

The data for adhesion is comparable to the data of the previous 5% butyl rubber preparation of the Declaration of August 16, 2004. As stated in the present Declaration:

At the 72nd hour after the application, the 1% and 5% butyl rubber preparations still had good applicability although only slight turn up was observed. The 15%, 20% and 30% butyl rubber preparations had good applicability without any turn-up.

Likewise, Table 2 of the present Declaration shows that the amount of abraded stratum corneum is significantly less with the claimed tape preparation in comparison to the D1 preparation and Comparative preparation of the Declaration of August 16, 2004. As is stated in the present Declaration:

As is evident from Table 2, the invention preparation of 5% butyl rubber added therein and the preparations with 1% to 30% butyl rubber added therein were confirmed to be of substantially the same level in the amount of abraded stratum corneum.

Applicants have therefore shown that tape preparations which contain butyl rubber in amounts of 1%, 15%, 20% and 30% provide substantially the same superior performance as the 5% butyl rubber-containing tape preparation of the Declaration of August 16, 2004.

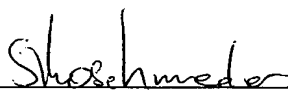
As indicated by the Examiner, the Declaration of August 16, 2004 may be sufficient for demonstrating the patentability of a tape preparation containing 5% butyl rubber because Applicants have shown that a 5% butyl rubber-containing tape preparation provides significantly superior or unexpectedly different performance in comparison to the prior art compositions. The present Declaration shows that compositions containing butyl rubber in amounts that span the entire 1-30% range recited in present independent Claim 1 provide significantly superior or unexpectedly different performance which is substantially similar to that provided by the 5% butyl rubber-containing tape preparation of the Declaration of August 16, 2004. Applicants therefore submit that the present Declaration is sufficient for demonstrating the patentability of the entire 1-30% range of butyl rubber as recited in present independent Claim 1.

Respectfully submitted,

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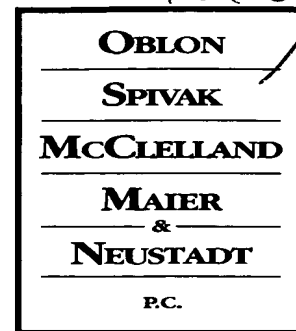


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RE: Application Serial No.: 09/786,370
Applicants: Yukino OWAKI, et al.
Filing Date: March 15, 2001
For: TAPE MATERIAL FOR TRANSCUTANEOUS
ABSORPTION
Group Art Unit: 1616
Examiner: GOLLAMUDI, S.

SIR:

Attached hereto for filing are the following papers:

Request for Extension of Time (2 Months)

Letter to the Examiner (3 pp.)

Declaration Under 37 C.F.R. § 1.132 (Executed Copy, 5 pp.)

Our credit card payment form in the amount of **\$450.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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